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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/676,545 | 09/29/2000 | Neil Katz | 6169-140 | 2722 |

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| EXAMINER | |
|---|---|
| BUI, KIEU OANH T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2611 | |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/676,545 | KATZ ET AL. | |
| | Examiner | Art Unit | |
| | KIEU-OANH T. BUI | 2611 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *12 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-9,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Remarks*

1. Claims 10-16 and 19-20 were withdrawn, and claims 21-27 were canceled in the amendment paper no. 7 (dated 05/07/04). Pending claims are now claims 1-9 and 17-18.

### *Response to Arguments & Priority*

2. Applicant's arguments with respect to claims 1-9 and 17-18 have been considered but are moot in view of the new ground(s) of rejection. The Examiner acknowledges the priority date is now at October 6, 1999 as claimed in the remarks/argument dated 09/20/04.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

4. Claims 1-9 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wistendahl et al. (US Patent 6,496, 981 B1 in view of Hooper et al. (U.S. Patent No. 5,442,390).

Regarding claim 1, Wistendahl discloses "a method for providing configurable access to media in a media-on-demand system comprising the steps of: delivering the media to a first client device through a first communications link wherein said first client device is associated with a first user; recording a bookmark specifying a position in the media; and delivering the media to a second client device through a second communications link, said delivery to said second client device beginning at said position specified by said recorded bookmark wherein

said second client device also is associated with said first user", i.e., as illustrated in Figure 4 and Figs. 7A & 7B, a first user of the interactive system associated with a first client device 32 (a set top box) can access to video-on-demand system or server (Fig. 3) by using an user input or pointer at 36 and/or 42, wherein the viewing device is a television, and the user can pause a viewing program by using bookmarking feature, for instance, hotspots detection and storing (Fig. 4 & col. 5/lines 25-50 & col. 15/lines 25-38), and the second client device (a personal video recorder, or VCR-like devices, col. 16/line 42 to col. 17/line 42) via a second communication link later helps the user to resume at the point where the user has not finished viewing the program or the first content, wherein the second client device is associated with the same first user (see col. 11/line 65 to col. 12/line 50 as key frames are used for identifying a specific location of stream if the user prefer to start at any particular location, and col. 16/line 42 to col. 17/line 42 for pausing or VCR-like functions in video on demand systems).

Wistendahl does not clearly show the step of resuming at the marked program or media with the use of a second device (as argued by applicants); however, Hooper clearly shows that the user device 12 connected to the set top box 11 can be a television, a VCR, a PC or a work station (Hooper, Figs. 1 & 12, and col. 3/lines 31-58). Therefore, as suggested by Wistendahl (col. 16/line 67 to col. 17/line 28 for later viewing or use) as well as Hooper (col. 3/lines 31-46 for pausing, resume, jump backward or forward, through the use of network 30), the user of viewing device 12 can be at anywhere, using any viewing device via the network for resuming the playing of the media or program that he/she pauses earlier, wherein the media is marked as segments with pointers as identifiers for later retrieving (Hooper, col. 11/line 5-col. 12/line 51 for further details). Therefore, it would have been obvious to one of ordinary skill in the art to

modify Wistendahl's system with Wistendahl's suggesting technique in marking the media during the pausing of the media, then later retrieving for viewing by using another device as clearly taught by Hooper.

As for claims 2 and 18, in view of claim 1 above, Wistendahl does not further mention the steps of identifying the devices; however, in a same environment of providing on-demand services to users, Hooper discloses "further comprising the steps of identifying device properties for each of said first and second client devices; and, delivering the media to said first and second client devices through said respectively established first and second communications links, the media delivered in a format compatible with said identified device properties", i.e., a configuration process including customer's information and the configuration of their device is performed for identifying a particular viewer and their associated device at their location on how to communicate to them (Hooper, Fig. 4/step 420, and col. 8/lines 4-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wistendahl's technique with well-known identifying technique as taught by Hooper in order to ensure the service to deliver to subscribed customers to avoid fraudulent activities.

As for claim 3, in further view of claim 2 above, both Wistendahl and Hooper further discloses "wherein the media is stored in a media-on-demand server (MODS) and delivered to said first and said second client devices via said first and said second communications link respectively", i.e., a media on-demand server for delivering video-on-demand (Wistendahl, Fig. 3, col. 7/lines 28-52 for video on demand addressed), and media is stored on media-on-demand server or VOS system 20 and delivered to the CPE 10 at different locations via corresponding

links (Hooper, Fig. 1 with arrows for links, i.e.,, twisted pair of wires, coaxial cables, fiber optic cables, micro-wave or satellite links, col. 3/lines 1-25).

As for claim 4, in further view of claim 3 above, Hooper further discloses "wherein said step of delivering the media to said first client device via said first communications link, comprises receiving the media from said MODS in an intermediate server; in said intermediate server, converting the media to a format compatible with said identified device properties of said first client device; and delivering said converted media to said first client device via said first communications link", i.e., the media is delivered via a first communications link to a first client device via an intermediate server as an interface box converter 11, this server converts the receiving media to a compatible format to the client device, for instance, HDTV to a television (Fig. 12, and col. 14/lines 4-54).

As for claim 5, in further view of claim 3 above, Hooper discloses "wherein said step of delivering the media to a second client device via said second communications link, comprises: receiving the media in an intermediate server from said MODS; in said intermediate server, converting the media to a format compatible with said identified device properties of said second client device; and delivering said converted media to said second client device via said second communications link", i.e., the media is delivered via a second communications link to a second client device via an intermediate server as an interface box converter 11, this server converts the receiving media to a compatible format to the client device, for instance, signals to a monitor of a personal computer PC (Fig. 12, and col. 14/lines 4-54).

As for claim 6, in further view of claim 3 above, Hooper discloses further "comprising: storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said plurality of media-on-demand servers storing the media in at least one format compatible with a selected device type; selecting a MODS for delivering the media to said first client device, said selected MODS having stored thereon the media in a format compatible with said first client device; and delivering from said selected MODS the media in a format compatible with said first client device", i.e., a library server 23 with a juke box 41 serves as a stored media for clients in selecting programs and each server stores media with compatible formats to the client device with different ports to different networks (Fig. 2, and col. 4/lines 18-53).

As for claim 7, in further view of claim 6 above, Hooper further discloses "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said first client device in a format compatible with said first client device; if it is determined that a MODS is not available for delivering the media to said first client device in a format compatible with said first client device, selecting a MODS for delivering the media to said first client device, said selected MODS containing the media in a standard format, and converting the media in said standard format to a format compatible with said first client device", i.e., a configuration process is performed for providing appropriate type of broadcasting program if available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being converted at the interface converter as in claim 5 above.

As for claims 8 and 9, in further view of claim 3 above, Hooper further discloses "further comprising: storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said plurality of media-on-demand servers storing the media in at least one format compatible with a selected device type; selecting a MODS for delivering the media to said second client device, said selected MODS having stored thereon the media in a format compatible with said second client device; and delivering from said selected MODS the media in a format compatible with said second client device" and "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said second client device in a format compatible with said second client device; if it is determined that a MODS is not available for delivering the media to said second client device in a format compatible with said second client device, selecting a MODS for delivering the media to said second client device, said selected MODS containing the media in a standard format, and converting the media in said standard format to a format compatible with said second client device", i.e., a configuration process is performed for providing appropriate type of broadcasting program if available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being converted at the interface converter as in claims 4-5 above, whether a second device is a HDTV television or a PC.

Regarding claim 17, Wistendahl discloses "a method for providing configurable access to media in a media-on-demand system comprising: delivering the media to a first client device in a format compatible with said first client device, wherein said first client device is associated with a first user; interrupting said delivery of said media; recording a bookmark specifying a position

in the media when said interruption occurred; and resuming delivery of the media to a second client device, said resumed delivery beginning at a position in the media specified by said recorded bookmark, wherein said second client device also is associated with said first user";

i.e., as illustrated in Figure 4 and Figs. 7A & 7B, a first user of the interactive system associated with a first client device 32 (a set top box) can access to video-on-demand system or server (Fig. 3) by using an user input or pointer at 36 and/or 42, wherein the viewing device is a television, and the user can pause a viewing program by using bookmarking feature, for instance, hotspots detection and storing (Fig. 4 & col. 5/lines 25-50 & col. 15/lines 25-38), and the second client device (a personal video recorder, or VCR-like devices, col. 16/line 42 to col. 17/line 42) via a second communication link later helps the user to resume at the point where the user hasn't finished viewing the program or the first content, wherein the second client device is associated with the same first user (see col. 11/line 65 to col. 12/line 50 as key frames are used for identifying a specific location of stream if the user prefer to start at any particular location, and col. 16/line 42 to col. 17/line 42 for pausing or VCR-like functions in video on demand systems).

Wistendahl does not clearly show the step of resuming at the marked program or media with the use of a second device (as argued by applicants); however, Hooper clearly shows that the user device 12 connected to the set top box 11 can be a television, a VCR, a PC or a work station (Hooper, Figs. 1 & 12, and col. 3/lines 31-58). Therefore, as suggested by Wistendahl (col. 16/line 67 to col. 17/line 28 for later viewing or use) as well as Hooper (col. 3/lines 31-46 for pausing, resume, jump backward or forward, through the use of network 30), the user of viewing device 12 can be at anywhere, using any viewing device via the network for resuming the playing of the media or program that he/she pauses earlier, wherein the media is marked as

segments with pointers as identifiers for later retrieving (Hooper, col. 11/line 5-col. 12/line 51 for further details). Therefore, it would have been obvious to one of ordinary skill in the art to modify Wistendahl's system with Wistendahl's suggesting technique in marking the media during the pausing of the media, then later retrieving for viewing by using another device as clearly taught by Hooper.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wolf et al. (U.S. Pat. No.5,461,415) disclose a system and method of supporting pause-resume in video-on-demand service.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to PTO New Central Fax number:**

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,*
*Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to "Krista" Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kieu-Oanh Bui
Primary Examiner
Art Unit 2611

KB
Oct. 25, 2005